



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,707	06/28/2000	KLAS HYLLANDER	2867-0180-6	9794

22850 7590 10/07/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

NGUYEN, SIMON

ART UNIT PAPER NUMBER

2685

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/485,707

Applicant(s)

HYLLANDER ET AL.

Examiner

SIMON D NGUYEN

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amendment filed 6/21/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-10, 12, 13, 16, 22-27, 29, 30, 33 and 35-38 is/are allowed.
- 6) ☒ Claim(s) 1-4, 11, 14-15, 17-21, 28, 31-32, 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 11, 14-15, 17-20, 28, 31-32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bannister et al. (5,943,399) in view of Voit (6,075,783).

Regarding claim 1, Bannister discloses a communication system for establish connections to and between internet users (fig. 1, abstract), wherein the communication system includes a cellular radio communication network (# 600) adapted to provide a short message service (# 620), a server for facilitating the establishment of a telephony/internet (# 300) connection between a mobile station (#650) and an Internet user (telephone #420 in combination of workstation 400 or telephone #110 in combination of workstation 100) (column 3 line 44 to column 7 line 57), and in that the SMS is used to transfer inquiry information (fig.9), comprising: from the mobile station to the server and from the server to the mobile station, information relating the connection between the mobile station and the Internet user (fig.9, column 7 lines 14-67, column 8 lines 1-5). However, Bannister does not specifically disclose that the Internet server transferring identifying an Internet address for the specific Internet user.

Voit discloses an Internet phone system in which a call from a calling party to a called party via an Internet server, wherein the calling party sends an address of the called party, in the textual form (short message), to the Internet server for establishing the call, wherein the Internet server converts the address to an IP address and return the IP address to the calling party (fig.4, column 9 line 7 to column10 line 67).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to have Bannister, modified by Voit to verify the condition of the called party in order to provide an appropriate Internet call service.

Regarding claim 18, this claim is rejected for the same reason as set forth in claim 1.

Regarding claims 2-3 and 19-20, in the modified Bannister system, Bannister further discloses transferring a specific identification of the mobile station to the server (figs.2, 6), wherein the specific ID of the mobile station is a telephone number (directory number) (column 7 lines 43-45).

Regarding claims 11, 15, 28, and 32, in the modified Voit system, Voit further discloses the server having a database for storing records of subscribers in the HLR and Domain Name server having IP address register wherein the records of subscribers including internet addresses of the subscribers and the calling party sends a Domain Name Address or telephone number to the Internet server for searching the IP address in a look up table for the called party (column 9 line 7 to column 10 line 32, column 12 lines 6-57). Therefore, it would have been obvious to one skilled in the art at the time

Art Unit: 2685

the invention was made to have Bannister, modified by Voit in order to decrease the connection time of a telephone call via the Internet.

Regarding claims 14 and 31, the modified Bannister system, Voit discloses the server sends the IP address to the calling party (column 9 lines 41-45) and the system stores a list of addresses (column 9 lines 28-45).

Regarding claims 17 and 34, Bannister discloses the system as a GSM system (column 6 line 38).

3. Claims 4 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bannister et al. (5,5,943,399) in view of Voit (6,075,783) as applied to claims 1 and 18, respectively, and further in view of Xu et al. (6,151,628).

Regarding claims 4 and 21, the modified Bannister system does not specifically disclose a specific identity as a telephone number of the mobile station, and the server includes analysis means to determine the mobile station.

Xu discloses an Internet communication system in which a specific identity for a mobile station is a telephone number (column 5 line 64 to column 6 line 1) and an Internet server includes an authentication server for analyzing a telephone number of the calling party for accessing or rejecting the Internet access (figs 6-11, column 11 lines 26-64). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modified the modified Bannister system with the teaching of Xu in order to prevent an illegal user of accessing the system.

Allowable Subject Matter

4. Claims 5-10, 12-13, 16, 22-27, 29-30, 33, and 35-38 are allowed.

Regarding claims 5, 12, 16, 22, 29, 33, 35 and 36, the prior art of record fail to disclose a return SMS from the telephony/Internet server to the mobile subscriber station including the telephony/Internet server's telephone number, wherein the mobile station uses the server's telephone number to place a call to the server prior to connect to a destination.

Regarding claims 6-10, 13, 23-27, 30, and 37-38, these claims are allowed as being dependent upon independent claim that has been allowed.

Response to Arguments

5. Applicant's arguments with respect to claims 1-4, 11, 14-15, 17-21, 28, 31-32, 34 have been considered but are moot in view of the new ground(s) of rejection.

Bannister and Voit, both disclose Internet's server establishing a voice call connection between a mobile station and an Internet user using a SMS.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon Nguyen whose telephone number is (703) 308-1116. The examiner can normally be reached on Monday-Friday from 7:00 AM to 4:00PM.

Application/Control Number: 09/485,707
Art Unit: 2685

Page 6

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F. Urban, can be reached on (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 306-0377.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

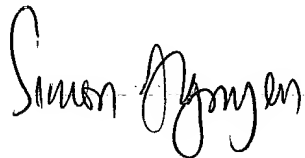
Or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Hand-delivered response should be brought to Crystal Park II,
2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Simon Nguyen

October 4, 2004

A handwritten signature in black ink, appearing to read "Simon Nguyen", is written over a horizontal dotted line.